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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PATEL, CHIRAG R	

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,730	RAMIG, RANDAL J.	
	Examiner	Art Unit	
	Chirag R. Patel	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,15-19,24,26-28,30 and 31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,15-19,24,26-28 and 30* is/are rejected.

7)☒ Claim(s) *31* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

Applicant's arguments filed August 28, 2006 have been fully considered but they are not persuasive. A discussion is provided below.

As per claims 1, 24, and 26, a closer review of cited prior art Strentzsch et al. (US 6,256,671) discloses per Col 12 lines 38-42 discloses "the present invention is implemented in discrete hardware or firmware. For example, in one alternate embodiment, an application specific integrated circuit (ASIC) is programmed with the above described functions of the present invention." This reads on claim limitations " wherein the requesting computer system is a single physical device docked to a resolving computer system"

A discussion of the newly added claims 30-31 is discussed in the body of the rejections. Examiner notes that claims 12-14, 20-23, 25, and 29 are cancelled by the applicant.

Allowable Subject Matter

Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose "...wherein the resolving computer system forwards the host name data from the replacement host name resolver in the requesting computer system to a name server, and wherein receiving a resolved address at the native host name resolver of the requesting computer system corresponding to the host

name data comprises receiving the resolved address directly from the name server bypassing the resolving computer system.

Claim Objections

Claims 2-11, 15-19 and 30-31 are objected to because of the following informalities: Claim 1 is directed to a system. Claims 2-19, and 30-31 which is dependent upon claim 1 is directed to a method. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer readable media is directed to non-statutory subject matter due to [0022] of applicant's disclosure "When information is transferred or provided over a network or another communications connection (either hardwired, wireless, or a combination of hardwired or wireless) to a computer system, *the connection is properly viewed as a computer-readable medium. Thus, any such connection is properly termed a computer-readable medium.*" Wireless signal on carrier wave is directed to non-statutory subject matter. A suggestion to make it statutory would be a computer readable storage medium.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amended phrase "serial connection does not support UDP" is a negative limitation that is not fully , clearly and concisely disclosed in applicant's disclosure.

Per MPEP 2173.05(i), "Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff 'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6-11, 17-19, 24 and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Strentzsch et al. – hereinafter Strentzsch (US 6,256,671).

As per claims 1, 24, and 26, Strentzsch discloses in a requesting computer system that is network connectable to a network, the requesting computer system including a native host name resolver that is not capable of resolving a host name when the requesting computer system is connected to the network due to advances in or proprietary name resolution techniques, a method for resolving a host name using a replacement resolver so as to extend the functionality of the computer system, extending the useful life of the computer system by allowing the computer system to be used on networks that it was not originally intended to be used with, the method comprising the following:

an act of assigning the requesting computer system as a name server for the requesting computer system, wherein the requesting computer system is a single physical device docked to a resolving computer system; (Col 5 line 54 – Col 6 line 10, Col 6 line 38-57;The gateway 250 may also include a DNS proxy 260; DNS proxy acts a "resolver" for DNS queries, Col 12 lines 38-42)

an act of at a native host name resolver of the requesting computer system requesting resolution of a host name by sending host name data in a first protocol to the requesting computer system by sending the host name data to the name server assigned for the requesting computer system, the host name data being compatible for resolution of the host name by a DNS server, the first protocol being a native protocol of the requesting computer system that is incompatible for resolving host name data over a communication link connecting the requesting computer system to the network; (Col 5 lines 38-53; The gateway 250 then forwards the requests to the Internet, either directly or via an ISP, making any necessary conversions so that the requests conform to the proper protocol)

an act of monitoring a name resolution port of the requesting computer system for receiving the host name data in the first protocol from the requesting computer system; (Col 5 lines 38-53)

an act of rerouting the host name data in the first protocol to a replacement host name resolver in the requesting computer system; and (Col 6 lines 38-57)

an act of sending the host name data from the replacement host name resolver in the requesting computer system using a second protocol to a module at the resolving computer system for resolving the host name data, wherein the second protocol is compatible for resolving host name data over the communication link connecting the requesting computer system to the network and (Col 5 lines 38 – 53, Col 6 lines 38-57, Col 12 lines 38-42)

an act of receiving a resolved address at the native host name resolver of the requesting computer system corresponding to the host name data. (Col 6 lines 38-57; This referral process continues until either an IP address is received)

As per claim 6, Strentzsch discloses the method as recited in claim 1, wherein the act of monitoring a name resolution port of the requesting computer system for receiving the host name data in the first protocol comprises the following: an act of monitoring a name resolution port of the requesting computer system that is associated with an IP network. (Col 5 lines 38-53, Col 4 lines 28-35)

As per claim 7, Strentzsch discloses the method as recited in claim 6, wherein the act of monitoring a name resolution port of the requesting computer system that is associated with an IP network comprises the following: an act of monitoring port 53 of the requesting computer system. (Col 5 lines 38-53, Col 4 lines 28-35; Port 53 is inherent to the DNS system because it is the default DNS port.)

As per claim 8, Strentzsch discloses wherein the act of monitoring a name resolution port of the requesting computer system for receiving the host name data in a host name resolution protocol comprises the following: an act of monitoring a name resolution port for receiving host name data in a host name resolution protocol that is compatible with an IP network. (Col 5 lines 38-53, Col 4 lines 28-35)

As per claim 9, Strentzsch discloses wherein the act of monitoring a name resolution port for receiving the host name data in a host name resolution protocol that is compatible with an IP network comprises the following: act of monitoring a name resolution port for host name data contained in one or more UDP packets. (Col 4 lines 9-26; UDP is inherent to the TCP/IP protocol stack)

As per claim 10, Strentzsch discloses wherein the act of monitoring a name resolution port of the requesting computer system for receiving the host name data in the first protocol comprises the following: an act of a replacement host name resolver monitoring a name resolution port for receiving host name data sent from a native host name resolver. (Col 5 lines 38 – 53, Col 6 lines 38-57)

As per claim 11, Strentzsch discloses the method as recited in claim 1, wherein the act of monitoring a name resolution port of the requesting computer system for receiving the name data in the first protocol comprises the following: an act of a resolving computer system monitoring a name resolution port for receiving host name data sent from a native host name resolver. (Col 5 lines 38 – 53, Col 6 lines 38-57)

As per claim 17, Strentzsch discloses wherein the act of sending the host name data from the replacement host name resolver in the requesting computer system using a second protocol to a module for resolving the host name data comprises the following:

an act of the of a replacement host name resolver rerouting the host name data to a module that was identified by entering one or more parameters in a user interface; (Col 5 lines 38 – 53, Col 6 lines 38-57)

As per claim 18, Strentzsch discloses the method as recited in claim 1, further comprising: an act of providing the requesting computer system with a network address by resolving the host name data that was sent to the module. (Col 6 lines 38-57)

As per claim 19, Strentzsch discloses the method as recited in claim 18, wherein the act of providing the requesting computer system with a network address by resolving the host name data that was sent to the module comprises the following: providing the requesting computer system with a numerical IP address by resolving a domain name that was sent to the module. (Col 4 lines 27-35)

As per claim 27, Strentzsch discloses the method as recited claim 26, wherein the one or more computer-readable media include physical storage media. (Col 11 lines 38-59)

As per claim 28, Strentzsch disclose the method as recited claim 26, wherein the one or more computer-readable media include system memory. (Col 11 lines 38-59)

As per claim 29, Strentzsch disclose the method as recited in claim 1, wherein the requesting computer system is a physical device. (Col 5 line 54 – Col 6 line 10, Col 6 line 38-57;The gateway 250 may also include a DNS proxy 260)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strentzsch (US 6,256,671) in view of Aziz et al. – hereinafter Aziz (US 6,119,234).

As per claim 2, Strentzsch discloses the method as recited in claim 1. Strentzsch fails to disclose loopback address. Aziz discloses wherein the act of assigning the requesting computer system as a name server for the requesting computer system comprises the following: an act of utilizing a loop-back address to assign the requesting computer system as a name server for the requesting computer system. (Col 8 lines 26-42) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose a loopback address in the disclosure of Strentzsch. The motivation for doing do would have been to allow a configuration when it is not desirable or possible to modify a client's resolver. (Col 8 lines 26-42)

As per claim 3, Strentzsch / Aziz disclose the method as recited in claim 2. Strentzsch fails to disclose the act of utilizing a defined IP loop-back address. Aziz discloses wherein the act of utilizing a loop-back address to assign the requesting computer system as a name server for the requesting computer system comprises the following: an act of utilizing a defined IP loop-back address to assign the requesting computer system as a name server for the requesting computer system. (Col 8 lines 6-18) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize a defined IP loop-back address in the disclosure of Strentzsch. The motivation for doing do would have been to allow the full resolver functionality to be implemented in one component. (Col 8 lines 19-25)

As per claim 4, Strentzsch / Aziz disclose the method as recited in claim 1. Strentzsch fails to disclose the act of assigning the requesting computer system as the primary name server. Aziz discloses wherein the act of assigning the requesting computer system as a name server for the requesting computer system comprises the following: an act of assigning the requesting computer system as the primary name server for the requesting computer system. (Col 8 lines 26-42) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to assign the requesting computer system as a primary name server. in the disclosure of Strentzsch. The motivation for doing do would have been to to allow the full resolver functionality to be implemented in one component. (Col 8 lines 19-25)

As per claim 5, Strentzsch / Aziz disclose the method as recited in claim 1. Strentzsch fails to disclose the act of assigning the requesting computer system as a DNS server. Aziz discloses wherein the act of assigning the requesting computer system as a name server for the requesting computer system comprises the following: an act of assigning the requesting computer system as a DNS server for the requesting computer system. (Col 8 lines 26-42) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to assign the requesting computer system as a DNS server in the disclosure of Strentzsch. The motivation for doing do would have been to to allow the full resolver functionality to be implemented in one component. (Col 8 lines 19-25)

As per claim 16, Strentzsch disclose the method as recited in claim 1. Strentzsch fails to disclose secure DNS. Aziz discloses wherein the first protocol is DNS and the second protocol is secure DNS. (Col 5 line 61 – Col 6 line 10) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose secure DNS in the disclosure of Strentzsch. The motivation for doing do would have been to authenticate the data in other resource records. (Col 5 line 61 – Col 6 line 10)

As per claim 30, Strentzsch disclose the method as recited in claim 1, wherein the wherein the requesting computer system docked to the resolving computer system through a serial connection, wherein the serial connection does not support UDP, but

does support TCP/IP. (Col 4 lines 9-26, Col 10 line 65 – Col 7 line 22; 110 ports 626 are one or more serial and/or parallel communication ports used to provide communication between additional peripheral devices which may be coupled to hardware system 600. Collectively, these elements are intended to represent a broad category of hardware systems, including but not limited to the Instant Internet.TM. device available from Bay Networks of Santa Clara, Calif.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Strentzsch (US 6,256,671) in view of Onweller (5,799,016).

As per claim 15, Strentzsch discloses the method as recited in claim 1. Strentzsch fails to disclose the first protocol is UDP and the second protocol is TCP. Onweller discloses wherein the first protocol is UDP and the second protocol is TCP. (Col 9 lines 39-62) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose the first protocol is UDP and the second protocol is TCP in the disclosure of Strentzsch. The motivation for doing do would have

been to support communication with standard that use different standards. (Col 9 lines 39-62; capable of translating between the tcp/ip, udp/ip)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R. Patel whose telephone number is (571)272-7966. The examiner can normally be reached on Monday to Friday from 7:30AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pairdirect.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

RUPAL DHARIA
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